

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

BRIEL et al.

Atty. Ref.: 36-1642

Serial No. PCT/GB01/01563, filed April 5, 2001

Group: unknown

Filed: Concurrently filed herewith

Examiner: unknown

For: DATA MANAGEMENT SYSTEM

* * * * *

Assistant Commissioner for Patents
Washington, DC 20231

RECEIVED

30 JAN 2002

Patent Division

Sir:
04/01/2002 NGUYEN 00000137 09980636

01 FC:122

PETITION UNDER RULE 47(A)

In accordance with the provisions of 37 CFR §1.47(a), 35 USC §116, second paragraph, and MPEP §409.03(a), it is respectfully requested that available joint inventors John Vander Briel, Stephen Ian Daleman, John Daniel Gabbe, Kenneth Andrew Lang, John Andrew Wojciechowksi, Paul Muschamp, Lindsay Alison Campbell, David Richard Griffiths, Brian Richard Henderson, Michael Hodgson, Jonathan Legh-Smith, Vineet Mittal be permitted to make application for United States letters patent on behalf of themselves and inventor William R. Brook (who refuses to join with this application). The captioned application and a Declaration signed by Roger Nash, patent attorney with co-assignee British Telecommunications, plc. is submitted simultaneously with this

Adjustment Date: 04/01/2002 NGUYEN
12/12/2001 UEDUVIJE 00000021 09980636
02 FC:151

~~130.00 OP~~

As evidenced by the attached Declaration of Roger Nash, inventor William Brook has so far refused to join in the captioned application. The attached Declaration of Roger Nash includes exhibits demonstrating diligent past efforts to obtain the cooperation of inventor Brook and his refusal to join in this application.

12/12/2001 UEDUVIJE 00000021 09980636

~~02 FC:151~~

~~130.00 OP~~

Best Available Copy

The last known address of the refusing inventor William Brook is listed in the Declaration and is repeated below:

William R. Brook
9 Ilmington Close, Hatton Park
Warwick
Great Britain
CV35 7TL

The petition fee of 37 CFR §1.17(i) is attached. The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever additional amount, if any, necessary for granting this petition.

It is respectfully requested that this Petition be granted.

Respectfully submitted,

NIXON & VANDERHYE P.C.

December 5, 2001

By: 

Larry S. Nixon
Reg. No. 25,640

LSN:SKK
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100

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* * * * *

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

**DECLARATION OF ROGER NASH IN SUPPORT OF
PETITION UNDER RULE 47(A)**

I, Roger Nash, a European Patent Attorney, hereby depose and declare as follows:

1. I am a British citizen employed by co-assignee of this application British Telecommunications, public limited company (hereinafter, "BT"), having offices at Holborn Center, 120 Holborn, LONDON EC1N 2TE, United Kingdom.

2. Assignees BT and AT&T employees performed joint research and development which resulted in two U.S. provisional patent applications. A first provisional application 60/194,606 was filed by AT&T on April 5, 2000. BT filed a second U.S. provisional application 60/214,399 on June 28, 2000.

3. Mr. William Brook is one of the joint inventors and was employed by AT&T at the time of filing the first provisional application.

4. Mr. Brook left the employment of AT&T on December 31, 2000.

5. A PCT application, PCT/GB01/01563 (hereinafter "PCT") was filed on April 5, 2001 and claimed priority from the first and second provisional applications.

6. BT and AT&T wish to enter US national phase (hereinafter, "U.S. National Phase") for the PCT application, the Article 22 deadline for filing a national phase application falling on December 5, 2001.

7. Twelve of the thirteen inventors have signed the inventors Declaration required for entry into the US national phase.

8. However, joint inventor William Brook has refused to sign the Declaration, despite diligent efforts by BT and AT&T. These diligent efforts and Mr. Brooks' refusal are evidenced by the attached letters between BT, AT&T, and Mr. Brook as referenced and explained below.

9. On April 30, 2001, Mr. Brook was requested to sign the Declaration. See attached Exhibit 1 (Letter from Ms. Radley at BT to Mr. Brook).

10. On May 16, 2001, responsive to the April 30, 2001 letter, Mr. Brook contacted Simon Roberts of BT's Intellectual Property Department by telephone and declined to sign the Declaration. See attached Exhibit 2 (e-mail from Simon Roberts to AT&T).

11. Mr. Brook explained that he thought himself was eligible for an inventor incentive award and was refusing to sign the Declaration at least until such award was settled in his favor. See attached Exhibit 3 (5/21/01 e-mail from Mr. Brook).

12. On May 21, 2001, AT&T's Mr. Monka requested Mr. Brook to sign the Declaration while he pursued the inventor incentive award matter of Mr. Brook with appropriate departments within AT&T. See attached Exhibit 4 (e-mail from Gary Monka to Mr. Brook).

13. In response, Mr. Brook alleged that AT&T failed to pay the inventor incentive award. He noted "...I have not received one dime nor even a verbal thank you... I'd like to see something happening." He further suggested that the matter be escalated to AT&T's directors with an indication that the incentive award is outstanding. See attached Exhibit 5 (e-mail from Mr. Brook to Gary Monka and Janice Brennan).

14. On June 25, 2001, Mr. Brook sent a further e-mail to the Intellectual Property Departments of BT and AT&T where he raised a number of possible substantive objections against this application. Those objections included his doubts as to the novelty and/or inventive step involved in the information model described in the application. See attached Exhibit 6 (6/26/01 e-mail from Mr. Brook to Janice Brennan and Gary Monka).

15. On June 27, 2001, AT&T attorneys continued to investigate the possible eligibility of Mr. Brook from a monetary award. See Exhibit 7 (e-mail from Susan McGahan to Rohini Ranjithkumar and Gary Monka).

16. During early July 2001, I ^{was} personally contacted ^{by} and spoke to Mr. Brook and he at that time repeated his refusal to sign even the Declaration (e.g., leaving the assignment for later). In response to his substantive novelty and/or inventive step allegations, I asked him to forward any relevant papers identified in his 6/25/01 e-mail. However, no such details have been received to date.

BRIEL et al.

Serial No: PCT/GB01/01563, filed April 5, 2001

17. I attempted to find the papers mentioned by Mr. Brook using library resources available to me including the World Wide Web, but was unable to identify any references that seemed relevant to the claimed invention.

18. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. I further declare that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

By:



Roger Nash

Date: 5th December 2001
Holborn, London

EVERY URGENTPHONE:
FAX:020 7492 8146
020 7242 0838

ADMIN RR

BTMr William R Brook
9 Ilmington Close
Horton Park
Warwick
CV35 7TL

30 April 2001

Dear Mr Brook,

Patent Formality Documents for filing foreign Patent ApplicationsBT Case Ref: **A26011**Title: **DATA MANAGEMENT SYSTEM**

I am currently completing formalities for the above case, on which you are an inventor and require, your signature and enclose various documents (and other action) as detailed in the attached schedule.

As there are strict deadlines for lodging documents abroad, I would be grateful if you could give this matter your PROMPT ATTENTION.

Please return the completed document(s) to me, at the address given below, by:

12 May 2001

(Self-addressed envelope enclosed for your convenience)

If you are unable to return the documents to me before the date requested, please contact me urgently to advise when you will be able to reply.

If you require any further guidance or information, please do not hesitate to contact me.

Many thanks for your assistance.

Yours faithfully

R.

Miss Samantha Radley
Formalities Manager**ENCLOSURE**

Document(s) for execution
Schedule of documents (with guidelines)
Self Addressed Envelope

H:\A26011\1.doc

BT Group Legal Services, Intellectual Property Department
120 Holborn, London EC1N 2TE

British Telecommunications plc
Registered Office
BT House, 100 Broad Street, London EC2A 7JF
Registered in England no. 1800000
BT is an ISO 9001 Registered Company

www.bt.com

-----Original Message-----

From: janice.brennan@bt.com [mailto:janice.brennan@bt.com]
 Sent: Wednesday, May 16, 2001 16:40
 To: monk@att.com
 Cc: billbrook@europa.com
 Subject: LA Patent Application - IFO ref: A26011/WO - Inventor: Bill Brook

2

Dear Gary,

As Erica Dutton has now left this department to work in private practice, this case has fallen to me.

I have today been speaking with one of the inventors, Bill Brook. For some reason Erica had assumed that Bill was a BT employee, but in fact he is a former employer of AT&T labs in the UK. I understand that at least his part of the labs closed down in December of last year. We should, therefore, have asked you to get the necessary signatures from Mr Brook. In view of his relationship to AT&T I now ask you to get the necessary signatures from him. However, he is currently declining to sign the power of attorney and the assignment. As Mr Brook has never been a BT employee, we have no means of forcing Mr Brook to sign.

Moreover, Mr Brook was one of the inventors named on the provisional patent application which I believe was filed by your department at the USPTO on 5th April 2000. I understand that as an AT&T employee Mr Brook was eligible for some kind of inventor's award on the filing of a patent application. Obviously Mr Brook is reluctant to sign the assignment and power of attorney until the matter of any payment due under the Inventor Incentive Scheme has been settled. Mr Brook struck me as a reasonable man and I can see why he has a problem with signing the papers at this time.

Moreover, from my conversation with him it is clear that Mr Brook had been working on some of the subject matter which is contained within the international patent application from as long ago as 1996. He mentioned the involvement of AT&T Switzerland and possible contact with a Turkish company around 1996 and with a Swiss company around 1997. I suggest that you look into the nature of any commercial dealings with any such companies at that time with regard to the effect that such activities may have on the validity of the present filing.

I look forward to hearing from you.

SIMON ROBERTS
 Tel: 020 7492 8104
 Fax: 020 7242 0585
 E-mail: simon.roberts@bt.com

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-----Original Message-----

From: Bill Brook (mailto:bill.brook@netscient.com)
 Sent: Monday, May 21, 2001 11:27 AM
 To: 'janice.brennan@bt.com'; wmk@att.com
 Subject: RE: LA Patent Application - IPD ref: A18011/WO - Inventor: Bill
 Brook

③

Folks -

I've been able to determine that \$750 should have been paid on filing with the US patent office, and that a further \$5000 is payable if the patent is 'Critical to the Success of a Licensing Opportunity'. This is under the 'AT&T Patent Recognition Program' which is managed by AT&T Intellectual Property Management. This information derives from the current (as of 21st May 2001) AT&T Intranet.

If my understanding is correct, it would appear that the initial payment should have already been paid in April 2000, over a year ago - or have I misunderstood something?

By the way, I was on the AT&T payroll until 31st December 2000. My departure was involuntary, being a result of the closure of AT&T Labs UK.

Any light anyone can shed on this I would be very grateful for ...

Bill Brook.

-----Original Message-----

From: Monka, Gary H - LGA [mailto:monka@att.com]
 Sent: Monday, May 21, 2001 16:39
 To: 'Bill Brook'; 'janice.brennan@att.com'
 Subject: RE: LA Patent Application - IPD ref: A26011/WO - Inventor: Bill Brook

Bill,

You should have received \$750 for filing the provisional application last year. I am not familiar with the background of this application -- Susan McHale-McGahan is handling this application for AT&T. She is away on maternity leave and will be returning to the office next month. I am just covering her prosecution docket in her absence and assisted in getting the joint application filed. I will advise her of the situation regarding the money you are owed upon her return.

In the interim, if you could execute the formal papers to at least get the international application underway, it would be greatly appreciated.

Gary H. Monka
 Senior Attorney
 AT&T IP Law
 (908) 221-8525 Tel.
 (908) 221-5783 Fax.
 e-mail: monka@lga.att.com

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+02074920880

27/11 '01 17:25 NO.713 08/12

Roberts, SC, Simon, GLI4 R

From: Brennan, J. Janice, GLI4 R
 Sent: 22 May 2001 14:45
 To: Roberts, SC, Simon, GLI4 R
 Subject: FW: IA Patent Application - IPD ref: A26011/WO - Inventor: Bill Brook

-----Original Message-----

From: Bill Brook [mailto:bill.brook@metascient.com]
 Sent: 22 May 2001 14:13
 To: 'Monika, Gary H - LGA'; 'janice.brennan@bt.com'
 Subject: RE: IA Patent Application - IPD ref: A26011/WO - Inventor: Bill Brook

Thanks for the information Gary.

As I knew this was progressing, I raised the issue of what happens with regard to patents with both AT&T HR and with my line management in New Jersey (Harry Burns) back in December, on several occasions, I got no answers, except to state that they had 'never heard of such a thing'.

I raised it again with AT&T HR a couple of weeks ago when the patent documents arrived for my signature. Again, I've received no answer.

Finally, I asked my wife to look it up on the intranet. She found the answers in about 10 seconds.

Clearly, in the above context, and given that I have not received one dime nor even a verbal thankyou for this as yet, I'd like to see something happening. It would appear from your mail and from the intranet that I should have received \$750 plus an amount to cover income tax in April 2000. Whilst I do not wish to appear petty (I'm not) having already received the brush off from everyone concerned, I'd like to see some signs of movement before I start spending my valuable time in helping AT&T and BT receive the patent it is due. I'm sure you understand.

Can I suggest that to get this moving, you email both Harry Burns (director of AT&T Labs consumer services) and Nick Forward (compensation and benefits manager) with a direction that this payment is outstanding.

Thanks for all your help,

Bill.

Chellaw at 903-221-9768 to report the error and then delete this message from your system.

EXHIBIT 6

-----Original Message-----

From: Bill Brook [mailto:bill.brook@netscient.com]
Sent: Monday, June 25, 2001 11:33 AM
To: 'janice.brennan@bt.com'; monkafatt.com
Subject: RE: IA Patent Application - IPD ref: A26011/WO - Inventor: Bill Brook

Hi. Just a brief update.

I've now had a chance to investigate the patent application and to refresh my memory both of the patent itself, and of the relevant patent law.

Whilst I'm in no way a patent lawyer (or any kind of lawyer for that matter) I believe there may be some issues relating to this application which require BT and AT&T to consider making changes to the application. The first issue is that of 'state of the art'. Some elements of the patent have been independently 'invented' by others, and are now in print. I do not have a comprehensive library available, but a brief glance through some of the books on my desk reveals that at least some elements have been published. For example, the aspects relating to parties, and the division into organisations and individuals, which is discussed in page 5 line 15, is fully discussed in the book 'Analysis Patterns' by Martin Fowler, ISBN 0-201-39542-0. Given that the information model was designed for practical reasons, and not to make money, it is highly likely that other aspects will either have been derived from books or papers, or will have been independently discovered.

Secondly, is the concept of disclosure. This model has been freely discussed, in detail, at a number of international conferences, such as Chil3PloP '98, '99, PloP 98, the AT&T Software Symposium, and others. I understand that disclosure invalidates a patent, except in very specific circumstances which you may wish to examine.

Thirdly, the information model is obvious, in that it describes familiar relationships such as a company forming a contractual relationship with another company. Whilst the language that has been chosen tends to conceal this obviousness (and not by my choice I might add), a process compounded by subsequent legal preparation, the simple fact is that much of the real heart of this model is obvious and therefore not patentable.

Fourthly, some parties who have contributed significantly to this model are not listed as inventors. Notably this includes Swisscom AG, SuperOnline (Istanbul), and Chris Maynes, an AT&T employee.

Let me know if I can be of further assistance in clarifying these issues.

Bill Brook
Chief Technical Officer
Netscient Ltd.

-----Original Message-----

From: janice.brennan@bt.com [mailto:janice.brennan@bt.com]

Ranjitkumar, R, Rohini, GU3 R

From: McHale-McGahan, Susan E - LGA [smchale@att.com]
Sent: 27 June 2001 20:50
To: 'ronini.ranjitkumar@bt.com'
Cc: Monka, Gary H - LGA; Cheliew, Linda - LGA
Subject: FW: IA Patent Application - IPD ref: A25011/WO - Inventor: Bill Brook

Importance: High

EXHIBIT 7

Rohini:

I am now reassuming responsibility for this case from Gary Monka, as I have just returned from maternity leave. I understand from my assistant Linda Cheliew that she has received 5 of the 6 signed documents from the US inventors, namely from Jack Wojciechowski; John Briel, Stephen Daleman, John Gabbe; and Ken Lang. We received an incorrect signed document from Vineet Mittal and are awaiting a corrected document from Mr. Mittal, before we send out the documents to you. That's the good news.

The bad news is Bill Brook refuses to sign the document and believes the invention to be obvious as detailed below. We are attempting to track down the status of his payment for the submission, but in the meantime

1. Can we file for another extension of time?
2. If Mr. Brook's is adamant about refusing to sign the document, can a petition be filed in the EPO requesting relief from having Brook's signature as he is deemed a hostile inventor (we have similar procedure in the US that allows us to file such a petition if an inventor refuse to cooperate, provided we can show evidence we undertook reasonable steps to get him to sign the document)?

Please let me know. Thank you.

Best regards,

Susan M. McGahan
Senior Attorney
AISI IP Law
phone: 908-221-5776
smchale@att.com

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